



**UNITED STATES PATENT AND TRADEMARK OFFICE**

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,001	11/24/1999	PAUL SENN	BCK-201	5697

25181 7590 02/24/2003

FOLEY HOAG, LLP  
PATENT GROUP, WORLD TRADE CENTER WEST  
155 SEAPORT BLVD  
BOSTON, MA 02110

EXAMINER

TRAN, PABLO N

ART UNIT PAPER NUMBER

2684

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/449,001

Applicant(s)

SENN ET AL.

Examiner

Pablo N Tran

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 10/31/02 have been fully considered but they are not persuasive.

The Applicant's stated that "Kirby fails to teach or suggest a location register that is capable of identifying a class of market associated with a mobile switching center and modifying the subscriber profiles as a function of the identified class of market".

As per claims 1, 12, 21, 28, 33, and 38, Kirby disclosed a national service hub (location register, see fig. 1/no. 70) upon identifying (where it is clear that upon the mobile terminal registered with the visited network 60, the mobile switching network's 60 class of market is identified) the mobile switching center's (fig. 1/no. 60) class of market is a non-subscription service provider (not-prepaid MSC, see specification, pg. 12/TABLE 1), the national service hub alters certain parameters of the subscriber's profile (see pg. 18/ln. 39-67). Furthermore, as evidence by the Applicant's remark (see amendment, no. 15, pg. 3/2<sup>nd</sup> full paragraph). Although, the Applicant states that Kirby reference teaches one scenario, but the examiner believes that Kirby reference stills read on the claim limitations, as claimed.

As per claims 43 and 51, As stated above, Kirby further discloses upon a mobile terminal registration with a mobile switching center, the MSC's class of market is identified whether it is a subscription (pre-paid platform association) or a non-

Art Unit: 2684

subscription (no pre-paid platform association) service providers (see fig. 1). If the mobile switching center is a subscription service providers, the national hub will route all calls through the pre-paid platform associated with the service provider (col. 12/ln. 42-67) and if the mobile switching center is a non-subscription service providers, the national service hub alters certain parameters of the subscriber's profile (col. 18/ln. 39-67) and route the call to a toll-free number (hot-line number). Therefore, the examiner believes that Kirby reference stills read on the claim limitations, as claimed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2684

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-53 are rejected under 35 U.S.C. 102(e) as being anticipated by *Kirby* (6,047,179).

As per claims 1, 12, 28, 33, 38, 43, and 51, *Kirby* disclosed a system for allowing a subscriber to a prepaid communication service to roam between a different service markets comprising: a serving MSC (fig. 1/no. 20, 60) capable of communicating with the subscriber's phone unit and capable of generating a request for a profile associated with the subscriber; a location register (fig. 21/no. 46, 49, col. 12/ln. 52-53) in communicating with the serving MSC and HLR (fig. 1/ln. 43) being capable of collecting the subscriber profile and capable of identifying a class of market (see specification, pg. 12/TABLE 1, where it is clear that the serving MSC class is identified as prepaid (subscription) and non-prepaid (non-subscription)) and modify the subscriber profile (col. 26/ln. 1-20) as a function of the identified class market for controlling the services provided to the subscriber (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col.

Art Unit: 2684

26/ln. 62); and a prepaid platform (fig. 1/no. 26, 46, 72) capable of performing call processing for a call associated with the subscriber.

As per claims 2 and 13, *Kirby* disclosed the location register includes a database having information representative of class of markets associated with a plurality of markets capable of servicing the subscriber (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 3 and 14, *Kirby* disclosed the location register includes a messaging processing unit for processing a message from the MSC to identify a class of market associated with the MSC (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 4 and 15, *Kirby* disclosed said MSC includes a profile request service capable of requesting a user profile to an NPA/NXX signal representative of the subscriber being a prepaid customer (TABLE A-F).

As per claims 5 and 16, *Kirby* disclosed the location register includes a memory space for storing information representative of a location associated with the subscriber (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 6 and 17, *Kirby* disclosed the location register includes means for providing a HLR with information representative of a location associated with the subscriber (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 7 and 18, *Kirby* disclosed the location register includes means for passing through registration requests for subscribers identified as not prepaid subscribers (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 8 and 19, *Kirby* disclosed the location register includes means for requesting subscriber location information from a HLR associated with the subscriber (col. 2/ln. 57-col. 3/ln. 20, col. 5/ln. 28-col. 7/ln. 14, col. 8/ln. 27-col. 9/ln. 40).

As per claim 9, *Kirby* disclosed the location register includes is in communication with the prepaid platform for delivering subscriber location information to the prepaid platform (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 10 and 20, *Kirby* disclosed the location register includes means for communicating with a VLR to allow call termination for a call (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claim 11, *Kirby* disclosed the location register includes an error reporter for reporting to detected error conditions to the prepaid platform (col. 18/ln. 44-col. 19/ln. 5).

As per claims 22 and 44, *Kirby* disclosed the call originates from at least one of a mobile telephone or a landline (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 23, 29, 34, and 39-40, *Kirby* disclosed modifying the profile associated with the subscriber to route the call to at least one of a prepaid platform located in the market associated with the MSC and a prepaid platform located in a market different than the market associated with the MSC (fig. 1, 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 24, 30, 35, 47-48, and 53-54, *Kirby* disclosed modifying the profile associated with the subscriber to route the call to at least one of a prepaid platform

Art Unit: 2684

located in the market associated with the MSC for the MSC to complete the call (fig. 1, 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 25, 27, 31, 36, 41, and 45, *Kirby* disclosed modifying the profile associated with the subscriber to route the call to a hotline (toll-free) number on a PSTN (col. 18/ln. 44-col. 19/ln. 5).

As per claims 26, 32, 37, 42, 46, 49-50, 52, and 55-56 *Kirby* disclosed modifying the profile associated with the subscriber to include a hotline (toll-free) number for a prepaid platform located in a market different than the market associated with the MSC (fig. 1, 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 18/ln. 44-col. 19/ln. 5, col. 24/ln. 29-col. 26/ln. 62).

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Vazvan (6,324,394) disclose prepaid telecommunication system.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (703)308-7941. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Hunter, can be reached at (703)308-6732.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Art Unit: 2684

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

**PABLO N. TRAN  
PATENT EXAMINER**

February 21, 2003

A handwritten signature in black ink, appearing to be 'P. Tran', with a stylized flourish.

AU 2684